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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,720	02/19/2004	Jack T. Oldham	1684-6036US (484-28684-US)	7639
24247	7590	01/13/2006	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,720

Applicant(s)

OLDHAM ET AL.

Examiner

Shane Bomar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-188 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-188 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-74 and 179-186, drawn to a casing bit with an aperture in a nose portion, a plurality of blades, and at least one gauge section adjacent the nose portion, classified in class 175, subclass 402.
 - II. Claims 75-143, drawn to a casing bit reamer with a pilot section having a first cutting structure with a plurality of blades, and a reamer section with a second cutting structure, classified in class 175, subclass 385.
 - III. Claims 144-147 and 150-153, drawn to a cutting element for use in a casing bit, wherein the cutting element has a substrate and an abrasive volume, the abrasive volume will be substantially removed from the cutting element in response to drilling the formation, classified in class 175, subclass 426.
 - IV. Claims 148 and 149, drawn to a cutting element for a casing bit, the element comprising an abrasive volume on the cutting face and a substrate substantially free of carbide, classified in class 175, subclass 426.
 - V. Claims 154-156, drawn to a method of forming a borehole with a casing bit that includes using a superabrasive cutting element and drilling through the casing bit, classified in class 175, subclass 57.

- VI. Claims 157 and 158, drawn to methods for cementing a casing within a borehole by first forming the borehole with a casing bit, causing a portion of the casing bit to fail to create an aperture, and flowing cement through said aperture, classified in class 175, subclass 57.
- VII. Claims 159-162, drawn to a drilling assembly for drilling two or more casing sections that are arranged in a telescoping relationship, wherein there are at least two casing bits of different diameter affixed to casing sections of different diameter, classified in class 175, subclass 321.
- VIII. Claims 163-167, drawn to a drilling assembly for drilling two or more casing sections that are of different diameter and are arranged in a telescoping relationship, wherein there is a drilling tool at the end of a casing section that drills a diameter exceeding a largest diameter the two casing sections, classified in class 175, subclass 321.
- IX. Claims 168-178, drawn to a drilling assembly with a casing bit, wherein a substance, or destructive element, renders the casing bit more drillable, classified in class 175, subclass 171.
- X. Claim 187, drawn to a method for removing cutting elements by heating the braze material to a sufficient temperature, classified in class 175, subclass 57.
- XI. Claim 188, drawn to a method for removing cutting elements by causing electric current to flow through the electrical disbonding material, classified in class 175, subclass 57.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not have an aperture formed in the nose portion for delivering fluid outside of the bit. The subcombination has separate utility such as a casing bit that can drill a casing section without the need for a pilot section or reaming section being drilled.

3. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a cutting element with a substrate and an abrasive volume. The subcombination has separate utility such as a cutting element for use in any type of bit.

4. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

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claimed because the combination does not require a cutting element with a substrate and an abrasive volume. The subcombination has separate utility such as a cutting element for use in any type of bit.

5. Inventions V and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case any other type of casing bit that does not require blades and/or a gauge section can practice the process.

6. Inventions VI and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to drill a casing section into a formation without the need for cement and still provide a properly cased section of borehole.

7. Inventions VII-VIII and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can use any other type of casing bit that does not require blades and/or a gauge section. The subcombination has separate utility such as in a drilling assembly that only requires one casing bit.

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8. Inventions IX and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination can use any other type of casing bit that does not require blades and/or a gauge section. The subcombination has separate utility such as in a drilling assembly that does not require a substance to make the bit more drillable.

9. Inventions X-XI and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case any other type of casing bit that does not require blades and/or a gauge section can practice the process.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

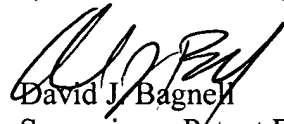
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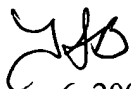
application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb 
January 6, 2006